



BOX AF
Response Under 37 CFR 1.116
Expedited Procedure Examining
Group 1771

PATENT
0014-0196P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: John WALTERS et al. Conf.: 3079
Appl. No.: 09/319,438 Group: 1771
Filed: June 7, 1999 Examiner: C. PRATT
For: NON-WOVEN INORGANIC FIBRE MAT

REQUEST FOR RECONSIDERATION

RECEIVED

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February 13, 2002

BOX AF

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

In response to the Examiner's Office Action dated August 13, 2001, the period for response having been extended three (3) months to February 13, 2002, Applicants respectfully submit the following amendments and remarks in connection with the above-identified application.

Remarks

Claims 12-32 are pending in the present application. Claims 1, 3, 22 and 32 are independent. Reconsideration of this application, in view of the following remarks is respectfully requested.

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Information Disclosure Statements

Applicants acknowledge receipt of the initialed copies of the PTO-1449's which were attached to the Information Disclosure Statements dated June 7, 1999 and March 1, 2000. However, under the section "Other Documents" the Examiner has not initialed adjacent to the Japanese Patent Abstract which was submitted with both of the above Information Disclosure Statements.

In view of the above, it is respectfully requested that the Examiner forward initialed copies of the PTO-1449's with the next Office Communication which indicate consideration of the Japanese Abstracts listed thereon.

Election/Restriction

Claims 14-32 stand withdrawn from further consideration by the Examiner as being directed to a non-elected invention. In the Examiner's Office Action, the Examiner sets forth a two-fold test for determining unity of invention. The Examiner indicates that the present claims do not meet the two-fold test, since the special technical feature does not make a contribution over the prior art.

Applicants are unaware of any two-fold test for unity of invention. In the Reply to Restriction Requirement dated June 27, 2001, Applicants fully explained their position with regard to the unity of invention in the present application. It is respectfully requested that the Examiner provide a basis for the two-fold test which the Examiner has described in the Office Action. It appears that the Examiner is considering novelty or inventive step in the unity of invention

decision. Novelty and inventive step are not a part of unity of invention. Accordingly, the Examiner should not be considering whether the special technical feature is allowable, but only whether the special technical feature is considered by Applicants to be a contribution over the prior art. In the present case, the special technical feature, although not considered by the Examiner to be allowable, is considered by the Applicants to be a contribution over the prior art. Accordingly, unity of invention is not lacking in the present case.

In view of the above, it is respectfully requested that the Examiner withdraw the Restriction Requirement and act on all of the claims in the present application.

Rejection Under 35 U.S.C. § 103

Claims 12-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chancellor, Jr., USPN 3,793,128 in view of Applicants' admitted prior art (AAPA). This rejection is respectfully traversed.

The present invention is directed to a non-woven mat of inorganic fiber. A combination of elements are recited including "said mat having a substance weight/unit area varying in a cross direction" and "at least one edge margin of said mat is of lower substance than the remainder of said mat." Applicants respectfully submit that the Examiner's modification of the Chancellor, Jr. reference would not be obvious to one having ordinary skill in the art.

In particular, Chancellor, Jr. discloses a floor mat for a chair having a gypsum and fiber core 16 with glass reinforced resin coatings 18, 20 on the top and the bottom, extending around the edges. The Examiner has identified that in Fig. 3, the top coating 18 is shown to have a "recess" to accommodate the bottom coating 20 when it is wrapped around the core, and says that this is an edge margin of lower substance as required by present claim 12. The Examiner accepts that there is no disclosure in Chancellor, Jr. that the glass fiber reinforced resin coating is "non-woven, but asserts that it would have been obvious to one having ordinary skill in the art to use non-woven glass mat to reinforce the coating of Chancellor, Jr.

Contrary to the Examiner's assertion, Applicants respectfully submit that the top glass fiber reinforced resin coating of Chancellor, Jr. is not a mat, as required by present claims 12 and 13. From lines 48-58 of column 2 and lines 16-26 of column 3 of Chancellor, Jr., it is clear that the top coating 18 is formed by applying uncured glass fiber reinforced resin as a liquid to the core 16 after the bottom coating 20 has been applied to the core. The liquid resin, containing chopped glass fiber as reinforcement, then hardens as it cures after the structure shown in Fig. 3 has been formed. The top coating 18 of Chancellor, Jr. is not, therefore, a mat, separate from either the core or the bottom coating 20, but is rather a partial shell formed with the core and the bottom coating 20.

There is no disclosure or suggestion in Chancellor, Jr., which would teach one having ordinary skill in the art to replace the top coating 18, which consists of

a continuous liquid resin phase in a discontinuous solid glass fiber reinforcement phase within the resin, by a non-woven mat of inorganic fiber as required by present claim 12, or that, even if he were to do so, he should use a mat with at least one edge margin of lower substance than the remainder of the mat to encapsulate the core, rather than simply compress the edges of the mat in the regions which they overlap. The obvious way of using the general structure of the Chancellor, Jr. reference with a mat in place of the coating 18 would be to provide a thinner region to accommodate the bottom coating 20, if necessary, by compressing the mat. Accordingly, this would maintain the substance of the mat uniform across the mat.

With regard to the Examiner's reliance on page 1 of Applicants' specification, Applicants respectfully submit that the Chancellor, Jr. chair mat is entirely non-analogous to the glass reinforced gypsum board described on page 1 of the Applicants specification. The glass reinforced gypsum board described in the present specification is a building board and not a chair mat as in Chancellor, Jr. One having ordinary skill in the art would not be motivated to look in the field of building materials to improve upon a chair mat.

Applicants respectfully submit that the Examiner is relying on impermissible hind sight in the present case. There is absolutely no suggestion in the prior art which would motivate one having ordinary skill in the art to modify the Chancellor, Jr. chair mat to substitute the glass fiber reinforced resin layer with non-woven glass. Furthermore, even if one having ordinary skill in the art

were motivated to make the substitution, a fact which Applicants do not agree, Applicants respectfully submit that there is absolutely no teaching which would suggest that the edge of the layer 18 be made having a lower substance than a remainder of the mat as required by independent claim 12. Referring to Fig. 3 of Chancellor, Jr., the coating 18 is applied to the outside surface of the core 16 in liquid form and therefore the thickness of the coating 18 is thinner at the location of the edges where the coating 18 overlaps with the coating 20. However, if one were to apply a non-woven mat of inorganic fiber to the outside of the core 16 in place of the coating 18, since the non-woven mat would not be in liquid form, it would not merely be applied to the outer surface of the core 16, but would have the edges compressed so that the edges of the layer 18 are thinner than the remainder of the layer 18. As mentioned above, mere compression of a layer does not change the substance of the layer but only changes the density. Accordingly, the modification proposed by the Examiner would still not arrive at the presently claimed invention.

In view of the above remarks, Applicants respectfully submit that claims 12 and 13 clearly define the present invention over the Chancellor, Jr. reference relied on by the Examiner. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103 are respectfully requested.

Conclusion

All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently pending rejections and that they be withdrawn.

It is believed that a full and complete response has been made to the Office Action, and that as such, the Examiner is respectfully requested to send the application to Issue.

In the event there are any matters remaining in this application, the Examiner is invited to contact Paul C. Lewis, Registration No. 43,368 at (703) 205-8000 in the Washington, D.C. area.

Applicants respectfully petition under the provisions of 37 C.F.R. § 1.136(a) and § 1.17 for three-month extension of time in which to respond to the Examiner's Office Action. The Extension of Time Fee in the amount of **\$920.00** is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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